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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,089

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Thomas Zirbs

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08/04/2009

PATENT CENTRAL LLC

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EXAMINER

SCHATZ, CHRISTOPHER T

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,089	Applicant(s) ZIRBS ET AL.	
	Examiner CHRISTOPHER SCHATZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/22/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 9-10 require that in the inserted position the roof liner protrude "over a roof frame member". Based upon a review of applicant's specification, it is unclear how one roof liner portion protrudes over a roof frame member. Figure 3 of the specification clear shows that the roof liner portion 24 protrudes *below* the frame member. It is recommended that the applicants replace "over" with "below".

3. Claim 1 recites the limitation that a feeding movement is "directed substantially perpendicular to the bonding face" in lines 20-22. There is insufficient antecedent basis for this limitation in the claim. The previous limitations in the claim do not recite the presence of a bonding face.

4. As to claim 2, it is recommended that in line 4 the applicant replace "a feeding movement" with "the feeding movement".

5. As to claim 7, use of the language "in particular" is indefinite because it is not clear if the fastening means is solely limited to adhesive bonding and a touch and close fastener.

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6. Claim 1 recites the limitation that a feeding movement is “the associated roof member crossmember” in the last two lines. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaulding et al. (US 6470559).

Spaulding discloses a method for mounting a roof module 18 on a roof frame structure, having a roof opening 12 of a vehicle body, wherein the roof module, which contains a roof module panel 20 and a roof liner 22, is brought from outside into a defined inserted position relative to the roof opening, thereby forming an adhesive connection (column 3, lines 4-11) with the roof frame structure, and wherein the roof liner in the inserted position has at least one roof liner portion 26 protruding over a roof frame member of the roof frame structure (see figure 5 – liner portion 26), wherein the roof module is at least temporarily positioned relative to the roof opening by means of a movement component (figure 1). Additionally, the reference discloses that the roof module is brought into an inserted position by a feeding movement directed

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substantially perpendicularly to the bonding face (figures 4 and 5) said movement being favorable to an adhesive connection (column 3, lines 4-11).

It is not clear if the roof module is moved into the thread-in position by in a longitudinal movement. However, the reference discloses that the movement component is used to align the pins 54 with the holes of the vehicle frame (figures 1 and 2; column 2, line 52 – column 3, line 11). Once the roof module is moved into a position wherein the liner has been inserted into the roof opening, it would have been obvious to one of ordinary skill in the art to move the roof module in a longitudinal direction in order to align the pins 54 with the holes in the roof frame. After pins are aligned, the roof module is moved in a direction perpendicular to the bonding face such that the pins are inserted into the holes. The position of the roof module right before the pins are inserted into the holes reads on the applicant's claimed "threaded-in" position.

As to claims 2 and 3, the guide pins 54 prevent movement in the longitudinal and traverse directions during the feeding movement. As to claim 4, the module is placed into the threaded-in position by means of a combined displacement and pivoting movement (figure 1). As to claim 5, the module is pressed in a controlled manner. As to claim 10, the reference discloses adhesive 52.

As to claim 7, Spaulding discloses that the liner is fastened to the inner portion of a roof frame cross member (column 3, lines 21-25; figure 5). As to claim 8, Spaulding discloses the limitations of the claim (column 3, lines 4-12).

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9. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaulding et al. (US 6470559) as applied to claim 1 above, and further in view of Kubo et al. (US 5165164).

It is not clear if Spaulding discloses a method wherein the operations of performing the threading-in, feeding and pressing of the roof module are carried out in an automated fashion. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the method of Spaulding such that the operations are carried out in an automated fashion as taught by Kubo (figure 12; column 10, lines 2 -68) as doing such allows the roof to be precisely aligned with the opening in the vehicle. As to claim 9, Kubo discloses front and rear roof panel portion with a connecting edge such that the roof panel portions rests on the outside of the frame cross member. Figure 12 of the reference shows two connecting edges at the front and rear of the roof W3. These connecting edges rest on the frame cross members of the roof opening thus enabling the roof to be properly secured to the frame member.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaulding et al. (US 6470559) as applied to claim 1 above, and further in view of Cliff (US 6213542).

Although it is not clear if the applicant intends to limit the fastening means recited in claim 7 to adhesive bonding or touch and close fastening, the following rejection is set forth to expedite prosecution:

While Spaulding discloses that the edge portion of the liner is secured to the roof frame (column 3, lines 21-25), it is not clear if Spaulding discloses a method wherein the

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securing means comprises a touch and close fastener. At the time the invention was made it would have been obvious to one of ordinary skill in the art to secure the liner portion of Spaulding to the roof frame with a touch and close fastener as doing such is well known and allows good retention between the frame and the liner portion as taught by Clift above (column 2, lines 50-52). Spaulding teaches the limitations of claim 8 as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791